

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte EARL E. HOYT

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Appeal No. 96-1596  
Application No. 08/106,489<sup>1</sup>

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ON BRIEF

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Before CALVERT, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 through 11 and 13 through 17, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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<sup>1</sup> Application for patent filed August 13, 1993.

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BACKGROUND

The appellant's invention relates to a combination cap and material tooling device. Claims 1 and 6 are representative of the subject matter on appeal and a copy of those claims, as they appear in the appellant's brief, is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) is:

Stull	2,930,063	March 29, 1960
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Claims 1, 2, 4 through 11 and 13 through 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stull.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 102(b) rejection, we make reference to the examiner's answer (Paper No. 10, mailed November 2, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 9, filed September 12, 1995) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

With this as background, we agree with the examiner that claim 1 "reads on" Stull. In that regard, we read claim 1 on Stull as follows: A combination cap and material tooling device (Stull's dispensing cap) comprising: a blade portion (the portion of Stull's blade 34 shown in Figure 1); an engagement portion for engaging a container in sealing engagement (the innermost portion of Stull's hub 16 having the threads which engage threads 22 of the tube 19, the innermost portion of Stull's skirt portion 11, Stull's lip 12 and Stull's bead 14); an intermediate portion extending between said blade portion and said engagement portion (the outermost portion of Stull's hub 16, the outermost portion of Stull's skirt portion 11, Stull's orifice portion 26 and sloping wall 27) wherein said intermediate portion and said engagement portion define a handle for supporting said blade portion; and wherein said intermediate portion includes opposing front and rear faces (Stull's sloping wall 27 and the portion of Stull's blade 34 which forms a part of the orifice portion 26) angled toward each other in a direction away from said engagement portion (as shown in Figures 3 and 4 of Stull).

The appellant's argument (brief, pp. 5-7) that Stull does not disclose each and every limitation recited in claim 1 is

unpersuasive for the following reason. As set forth above, Stull does disclose each and every limitation recited in claim 1. In that regard, contrary to the appellant's argument, Stull does disclose an intermediate portion located between the blade portion and the engagement portion of his dispensing cap. Furthermore, Stull's sloping wall 27 and the portion of Stull's blade 34 which forms a part of the orifice portion 26 (as shown in Figures 3 and 4) oppose each other and are angled towards each other. Additionally, in our view, the intermediate and engagement portions together (i.e., all of Stull's dispensing cap except for that part of blade 34 shown in Figure 1) define a handle for supporting the blade portion.

For the reasons presented above, we sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b).

The appellant has grouped claims 1, 2, 7 and 8 as standing or falling together.<sup>2</sup> Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 2, 7 and 8 fall with claim 1. Thus, it follows that the examiner's rejection of claims 2, 7 and 8 under 35 U.S.C. § 102(b) is also sustained.

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<sup>2</sup> See page 4 of the appellant's brief.

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With regard to claim 4, we agree with the examiner that claim 4 "reads on" Stull. In that regard, we note that the curved wall forming part of the orifice portion 26 includes opposing side walls which extend between Stull's sloping wall 27 (i.e., the front face) and the portion of Stull's blade 34 which forms another part (i.e., the rear face) of the orifice portion 26. With regard to claim 5, we agree with the examiner that claim 5 "reads on" Stull. In that regard, we note that Stull's sloping wall 27 (i.e., the front face) is substantially planar. In addition, the portion of Stull's blade 34 which forms a part (i.e., the rear face) of the orifice portion 26 is substantially planar. Accordingly, we will sustain the examiner's rejection of claims 4 and 5 under 35 U.S.C. § 102(b) since each and every element set forth in these claims is found in Stull.

We agree with the appellant that claims 6, 9 through 11 and 13 through 17 do not "read on" Stull. In that regard, Stull does not disclose a concave recess as recited in claims 6, 9 and 17. We fail to find any disclosure in Stull that the juncture of the surfaces of elements 16 and 11 forms a concave recess as alleged by the examiner (answer, p. 4). Accordingly, we will not sustain the examiner's rejection of claims 6, 9 through 11 and 13 through

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17 under 35 U.S.C. § 102(b) since each and every element set forth in these claims is not found in Stull.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4, 5, 7 and 8 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 6, 9 through 11 and 13 through 17 under 35 U.S.C. § 102(b) is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPENDIX

1. A combination cap and material tooling device comprising:  
a blade portion;

an engagement portion for engaging a container in sealing  
engagement;

an intermediate portion extending between said blade portion  
and said engagement portion wherein said intermediate portion and  
said engagement portion define a handle for supporting said blade  
portion; and

wherein said intermediate portion includes opposing front  
and rear faces angled toward each other in a direction away from  
said engagement portion.

6. The device as in claim 1, wherein said intermediate portion  
includes a finger depression defined by a concave recess for  
receiving a finger of an operator and for providing an indicator  
for properly orienting the blade portion.

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APJ NASE

APJ CALVERT

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 16 Sep 97

**FINAL TYPED:**